

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated August 4, 2008, (hereinafter Office Action) have been considered, and reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Without acquiescing to characterizations of the asserted art, Applicant's claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant's claimed subject matter, Applicant has amended independent Claims 1, 5, 10, 15, and 17 to indicate that the comparison is based on a user-defined degree of non-matching preference data included in preference data related to the user of the mobile terminal device which received the preference profile. Support for the changes may be found in the Specification, for example, at paragraphs [0011]-[0013] (page 2, line 31 – page 3, line 17); therefore, the changes do not introduce new matter. Each of the pending claims is believed to be patentable over the asserted references for the reasons set forth below.

Neither WO 01/86997 to Varland (hereinafter "Varland") nor "The Bayou Architecture" by Demers *et al.* (hereinafter "Demers") alone, or in combination, teaches or suggests at least that a comparison of preference data is based on a user-defined degree of non-matching preference data included in the mobile terminal device which received the preference profile. Instead, Varland is directed to finding profile parameters of clients that match. Since Demers is silent with respect to any comparison of preference profiles, Demers does not overcome the deficiencies in the teachings of Varland. As neither of the asserted references teaches or suggests at least these limitations, the asserted combination of teachings must also fail to correspond to such limitations. Without correspondence to each of the claimed limitations, the § 103(a) rejections would be improper.

Applicant further traverses the rejections of independent Claims 3, 12, and 22 because neither Varland nor Demers teaches or suggests receiving a notification from a server that includes data to enable access of a user to a multiple access online application, as claimed. Rather, the cited portions of Varland indicate that the initiation signal (asserted as corresponding to the claimed data to enable access) is sent by service providers and not the clearinghouse (asserted as corresponding to the claimed server). Since the asserted

alignment of the teachings of Varland fail to correspond to the claimed limitations, the rejections based upon such alignment are improper. Applicant accordingly requests that each of the § 103(a) rejections be withdrawn.

Dependent Claims 2, 4, 6-8, 18, 19, and 20 depend from independent Claims 1 and 3, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the asserted combination of Varland and Demers. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the above remarks made in connection with the independent claims. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 4, 6-8, 18, 19, and 20 are also patentable over the asserted combination of Varland and Demers.

With respect to the § 103(a) rejections of Claims 12-16 based upon Varland and Demers in view of U.S. Patent No. 5,630,159 to Zanchi, and U.S. Publication No. 2002/0013869 to Taniguchi *et al.*, respectively, Applicant respectfully traverses. As discussed above, Varland and Demers fail to correspond to the limitations of independent Claims 12 and 15 (from which Claims 13, 14, and 16 depend). The further reliance on these additional teachings does not overcome the above-discussed deficiencies in Varland and Demers. Thus, the asserted combinations of these teachings with the teachings of Varland and Demers do not teach each of the claimed limitations of Claims 12-16, and each of the § 103(a) rejections should be withdrawn.

Applicant further respectfully maintains the traversal of each of the § 103(a) rejections, each of which is based upon a combination of Varland and Demers, because the asserted modification of Varland would at least improperly change the principle of operation of Varland. Varland is directed to matching user profiles to notify users having

similar matching profiles that are in close proximity. Modifying Varland to use a local mobile terminal as a server would render the location-based profile matching impossible unless all user terminals would send their current location information to that terminal. Using a local mobile server as taught by Demers would change the principle of operation of Varland in violation of MPEP § 2143.01(VI). For at least these reasons, a skilled artisan would not be motivated to modify Varland as asserted, and the asserted modification is improper.

The assertion that a skilled artisan would look to the teachings of Demers to allow Varland's proximity matching be performed without being tied to a non-mobile server is also based upon hindsight reasoning. First, Demers makes no mention of, and is unrelated to, profile matching. Second, the Bayou architecture taught by Demers is directed to user devices disconnected from a larger system (page 6, lines 8-10). A skilled artisan using common sense would not look to use Demers' Bayou architecture, which is limited to the devices disconnected from a larger network, to find other users with matching profile information in close proximity. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). "Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). Therefore, Applicant respectfully submits that the proffered motivation is a hindsight combination of prior art based on Applicant's teachings, and the requisite showing of motivation to combine Varland with Demers has not been met. Applicant accordingly requests that each of the § 103(a) rejections be withdrawn.

It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially

noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Claims 1, 3, 5, 12, 15, and 17 have also been amended to alter the wording of the claims. For example, the preambles have been shortened. These changes are not made for any reasons related to patentability or to the asserted references and do not introduce new matter. These claims, with or without the changes, are believed to be patentable over the teachings of the asserted references for the reasons set forth above.

Authorization is given to charge Deposit Account No. 50-3581 (BKS.002.WUS) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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